



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/014,864

12/11/2001

Michael J. Tari

ICOR-004

3644

26137

7590

11/16/2006

PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10036

EXAMINER

GREIMEL, JOCELYN

ART UNIT

PAPER NUMBER

3693

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,864

Applicant(s)

TARI ET AL.

Examiner

Jocelyn Greimel

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 1-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>see attached</u> | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statements: 12/11/2001, 03/22/2002, 09/08/2003, 02/02/2004, 09/17/2004.

DETAILED ACTION

1. This non-final action is in response to Applicant's application of 11 December 2001, which claims the benefit of 60/254,680 filed 11 December 2000. The Examiner acknowledges the Information Disclosure Statements of: 11 December 2001, 22 March 2002, 08 September 2003, 02 February 2004 and 17 September 2004. Claims 1-14 are pending and are presented to be examined upon their merits. Claims 1, 8, 12 and 14 are independent claims.

Specification

2. The Oath and Declaration as currently amended lists Inventors: Angelo M. Toglia, Neil A. Chriss and Jeffrey R. Larsen. If needed, appropriate correction is required.

3. The title of the invention is objected to because the title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Appropriate correction is required.

4. The Specification is objected to because it contains acronyms, which are not described using the series of words that create the acronym. An example is "HTML" on page 4 of the Specification. Appropriate correction is required.

5. The claims use the term "tradeable" which should be spelled "tradable." Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claim 1 recites the claim language "said responses." There is insufficient antecedent basis for this limitation in the claim. Since this is the first occurrence of the limitation, it should not be preceded by "said." Applicant uses the terminology "at least one response", "said response" and "said responses." Clarification of all these claim terms is required.

7. Claim 1 recites the claim language "said trader." There is insufficient antecedent basis for this limitation in the claim. Since this is the first occurrence of the limitation, it should not be preceded by "said." Additionally, the claims use the term "trade on" and this could be confusing (it could be read as auctioning, bidding on or swapping). Examiner suggests clarifying this term or using a different term. Clarification of the claim terminology is required.

8. Claim 1 recites the claim language "said responders." There is insufficient antecedent basis for this limitation in the claim. Since this is the first occurrence of the limitation, it should not be preceded by "said." Clarification of the claim terminology is required.

Art Unit: 3693

9. Claim 1 recites the claim language "said second period." There is insufficient antecedent basis for this limitation in the claim. Since this is the first occurrence of the limitation, it should not be preceded by "said." Clarification of the claim terminology is required.

10. Claim 5 recites the claim language "said requestor's trading group" and "said at least one responder's trading group." There is insufficient antecedent basis for this limitation in the claim. Since this is the first occurrence of the limitation, it should not be preceded by "said." Clarification of the claim terminology is required.

11. Claim 8 recites "a second exclusivity period" but no first exclusivity period is claimed. This is confusing and clarification of the claim terminology is required. The claims have not been checked for every additional antecedent basis and/or clarity problem. Applicant is required to review and correct any additional claim language issues.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3693

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. **Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luke et al (US Patent No. 6,131,087, hereinafter Luke).** In reference to claims 1, 8, 12 and 14, Luke discloses a *method and system* of electronically trading financial instruments including:

- a. receiving a request for proposal ("RFP") on a financial instrument from a requestor, the RFP including an RFP structure (col. 4, lines 4-25);
- b. providing an alert to each trader whose tradable structures include the RFP structure (col. 4, lines 4-25; col. 5, lines 53-67);
- c. during a first response period, receiving at least one response to said RFP from at least one responder (col. 5, line 14 – col. 6, line 55; col. 9, line 1 – col. 10, line 19);

- d. transmitting said at least one response to said requestor and said at least one responder, each said plurality of traders not receiving said responses unless said trader comprises said requestor or said at least one responder (col. 5, line 14 – col. 6, line 55; col. 9, line 1 – col. 10, line 19);
 - e. allowing said at least one requestor to trade on said responses during a second exclusivity period, each said plurality of traders not being allowed to trade on said response during said second exclusivity period unless each said trader comprises said requestor, said first response period and said second exclusivity period being allowed to overlap (col. 9, line 48 – col. 10, line 34); and
 - f. at the expiration of said second exclusivity period, allowing said at least one responder to trade on said responses during a third exclusivity period, said plurality of traders not being allowed to trade on said responses during said third exclusivity period unless each such trader comprises a requestor or said at least one responder (col. 6, lines 12-55; col. 9, line 1 – col. 10, line 34).
15. In reference to claim 2, Luke teaches the electronic trading method and system further comprising matching orders at the expiration of said first period and before allowing said responders to trade on said responses (col. 5, line 14 – col. 6, line 55; col. 9, line 1 – col. 10 line 34).

16. In reference to claim 3, Luke discloses the electronic trading method and system wherein said orders are associated with a bid price or an offer price, said matching orders process further comprising matching crossed orders in which the highest bid prices is higher than the lowest offer price (col. 6, line12 – col. 10, line 19).

17. In reference to claim 4, Luke discloses the electronic trading method and system wherein any responses, which have not been traded on at the end of, said second period are migrated to a general market (col. 6, line12 – col. 10, line 19, *Luke discloses various "market participants" which could include the general market as an entity and a participant.*).

18. In reference to claim 5, Luke discloses the electronic trading method and system wherein traders are grouped into trading groups, said method further comprising transmitting said at least one response to said requestor's trading group and said at least one responder's trading group, each said plurality of traders not receiving said responses unless said trader comprises a trader in said requestor's trading group or said at least one responder's trading group (col. 6, lines 35-66, col. 9, line 1 – col. 10, line 19, *Luke discloses sorting according to level of congruence.*).

19. In reference to claims 6-7, 9 and 11, Luke discloses the electronic trading system:

- g. allowing trader's in said requestor's trading group to trade on said responses during said first period, each said plurality of traders not being allowed to trade on said response during said first period unless said trader comprises a trader in said requestor's trading group (col. 6, lines 35-66);
- h. allowing traders in said responder's trading group to trade on said responses during said second period (col. 6, lines 35-66, col. 9, line 1 – col. 10, line 19);
- i. wherein said tradable structures for each said trader are a function of potential traders to a trade (col. 6, lines 12-19);
- j. migrating said responses to a general market at the expiration of said third exclusive period (*As described in the evaluation of claim 4 supra.*).

20. In reference to claim 10, Luke discloses the electronic trading method and system wherein said first period and said second period are co- terminus (col. 6, lines 35-66, col. 9, line 1 – col. 10, line 19, *The number of trading periods to use is a business choice.*).

Conclusion


21. Other references not cited in the action but relevant to the evaluation are:
- i. Ordish et al (US Patent No. 5,727,165)
 - ii. Lange (US Patent No. 6,321,212).

Art Unit: 3693

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The Examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached at (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
November 8, 2006


ELLA COLBERT
PRIMARY EXAMINER